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PATENT

Customer No. 22,852

Attorney Docket No. 05905.0108-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Kei NAKAJIMA et al.

Serial No.: 09/554,065

Filed: May 10, 2000

For: CHARACTER COMMUNICATION
DEVICE

Commissioner for Patents and Trademarks
Washington, DC 20231

Group Art Unit: Not Assigned

Examiner: Not Assigned

RECEIVED

31 DEC 2001

Legal staff
International Division

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03 JAN 2000
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DEC 12 2001

OFFICE OF PETITIONS

RESPONSE TO DECISION ON APPLICANTS' PETITION
UNDER 37 C.F.R. § 1.47

Sir:

In response to the "Decision on Petition Under 37 C.F.R. 1.47(a)," ("Decision") mailed May 11, 2001, Applicants hereby submit supplemental evidence supporting their Petition. In addition, Applicants respectfully request reconsideration of the denial of the Petition.

As background, on June 13, 2000, the United States Designated/ Elected Office (DO/EO/US) mailed a Notice of Missing Requirements under 35 U.S.C. §371 indicating that an Oath and Declaration in compliance with 37 C.F.R. §1.497 (a) and (b) must be provided. Applicants timely responded by filing a Petition Under 35 C.F.R. §1.47(a), a Request for extension of time and \$1,890.00 extension fee, the \$130.00 surcharge fee, a Declaration signed by three of the five co-inventors, the \$130.00 petition fee and a declaration of Mr. Kouji Tsuchiya ("Tsuchiya Decl.").

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The Decision, mailed May 11, 2001, indicated that, while the Petition complied with the portions of 37 C.F.R. § 1.47 requiring a petition fee and the inclusion of the last known address of the omitted inventor, the Petition failed to satisfy all requirements of 37 C.F.R. §1.47(a). Specifically, the Decision indicated that the Petition failed to include documentary evidence and that "Applicants must submit any copies of relevant documentary evidence to confirm that a diligent attempt was made to contact Mr. Nakajima." In addition, the Decision indicated that the declaration was signed by only three of the five listed co-inventors.

In response, Applicants submit herewith relevant documentary evidence to confirm that a diligent attempt was made to contact Mr. Nakajima and a declaration signed by four of the five listed inventors. With respect to the documentary evidence, Applicants submit herewith copies of a first and second letter (and accompanying English language translations) sent by Mr. Kouji Tsuchiya to Mr. Kei Nakajima (the non-signing co-inventor). The first letter was sent to Mr. Nakajima at his last known address. The second letter was sent to the last known address of Mr. Nakajima's parents. In addition, Applicants submit copies of the envelopes in which each letter was sent (and accompanying English language translations), indicating the Japanese Post Office was unable to forward the letters to Mr. Nakajima at either address.

Further, Applicants submit copies of a first and second email (and accompanying English language translations) sent to the colleagues of Mr. Nakajima requesting an address for Mr. Nakajima. The replies to each of the emails indicates that no address was known for Mr. Nakajima. Finally, Applicants submit a copy of an Interoffice Circulate (and accompanying English language translation) sent to the Personnel

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Division at Mr. Nakajima's employer requesting Mr. Nakajima's address. The response reports the last known address of Mr. Nakajima, and his parents, as filed with the Applicant's petition.

Applicants submit that this documentary evidence overcomes the first ground for rejection of the Petition.

With respect to the Declaration, Applicants submit herewith a Japanese language Declaration (PTO/SB/106) (5 pages) executed by the four available co-inventors. Applicants submit that this Declaration overcomes the second ground for rejection of the Petition.

Applicants request that this supplemental information be considered, in light of Applicant's *bona fide* effort to comply with the requirements of 37 C.F.R. § 1.47 with the original Petition. See MPEP § 409.03.

The Petition as originally filed included the last known address of the unavailable inventor (19-20-511, Chuo-Rinkan 3-chome, Yamato-shi, Kanagawa-Ken, 242-0007) and the last known address of his parents (c/o Mr. Koichi Nakajima, 26-3 Ichiban-cho 1-chome, Tachikawa-shi, Tokyo, 190-0033). In addition, the Petition as originally filed included an executed Declaration of Mr. Tsuchiya (a copy of which is filed herewith), stating the facts of his efforts to contact Mr. Nakajima.

In light of this evidence, Applicants respectfully request the grant of the Petition under 37 C.F.R. § 1.47(a). Applicants submit that all requirements have been fulfilled. Namely, Applicants submit that the Declaration of Mr. Tsuchiya (a copy of which is filed herewith), together with the documentary evidence, fulfill the requirement for proving the pertinent facts of unavailability; the last known address of the inventor has been

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provided; and the petition fee has been paid. Furthermore, a Declaration executed by the four available inventors and filed herewith, satisfies the Declaration requirement.

Applicants therefore submit that all requirements of C.F.R. 1.47(a) and MPEP Section 409.03(d) are satisfied, and respectfully request the timely grant of Applicants' Petition under 37 C.F.R. § 1.47(a).

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 11, 2001

By: 

Richard V. Burgujian
Reg. No. 31,744

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